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EXAMINER

NGUYEN, VAN H

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/772,285	<b>Applicant(s)</b> BOCHKAREV ET AL.	
	<b>Examiner</b> VAN H. NGUYEN	<b>Art Unit</b> 2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is responsive to the Requirement for Restriction filed 08/28/2008.

Claims 1-12 are pending. Claims 1-8 (Group I) have been elected with traverse.

Applicant is required to cancel non-elected claims 9-12 in the next response to this office action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Election/Restrictions**

2. Applicant's election with traverse of Group I (claims 1-8) in the reply filed 08/28/2008 is acknowledged. The traversal is on the ground(s) that the claims in the groups are not significantly different. This is not found persuasive because of the following.

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It is the examiner's opinion that there are significant differences between Group I (claims 1-8) and Group II (claims 9-12). Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility because it does not require *"receiving 16 bit dialogue window information of the device from the operating system; converting the received 16 bit dialogue window information to 32 bit dialogue window information"*. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for one group is not required for the other groups, restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

### **Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. under 35 U.S.C. 101

**Regarding independent claim 1**, the language of independent claim 1 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Independent claim 1 does not appear to require any computer hardware to implement the claimed invention. These claims appear to define the metes and bounds of an invention comprised solely of software.

If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. In re Schrader, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994).

The claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” State Street, 149 F.3d 1368, 1373, 47 USPQ2d 1596 at 1601-02 (Fed. Cir. 1998). MPEP 2106. However, State Street does not hold that a “useful, concrete and tangible result” alone, without a machine, is sufficient for statutory subject matter.

Dependent claims 2-3 are rejected for fully incorporating the deficiencies of their base claim.

**Regarding independent claim 4**, the claim recites an “apparatus” comprising “a framework”. As currently recited the “apparatus” comprises only computer software element(s). Thus, the claim is a program per se and does not fall within any of the four enumerated categories of patentable subject matter in section 101.

For the same reasons discussed supra with respect to independent claim 1, dependent claims 5-7 fall outside the scope of § 101.

### **Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by **Hart et al.** (US 6763518 B2).

#### **As to claim 1:**

Hart teaches (see Abstract; col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) a method of displaying a dialogue window of a device performed by a device control portion, the method comprising:

- requesting an operating system supporting a 16 bit device control portion to display a 32 bit dialogue window for exchange of information between a user and a predetermined device and not a 16 bit dialog window;
- receiving 16 bit dialogue window information of the device from the operating system;

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- converting the received 16 bit dialogue window information to 32 bit dialogue window information; and
- displaying the 32 bit dialogue window corresponding to the converted 32 bit dialogue window information and not displaying the 16 bit dialog window.

**As to claim 2:**

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) the converting comprises: generating 32 bit base dialogue window information having no content of the 32 bit dialogue window; and modifying the 16 bit dialogue window information to the converted 32 bit dialogue window information, in response to the 32 bit base dialogue window information.

**As to claim 3:**

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) the 16 bit dialogue window information comprises a plurality of 16 bit dialogue window page information and the displaying comprises displaying as the converted 32 bit dialogue window information, converted 32 bit page information in response to a request by the user for one of the 16 bit dialogue window page information in the 32 bit dialogue window.



**As to claim 4:**

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10)an apparatus displaying a device dialogue window according to dialogue window information, the apparatus comprising:

- a first interface portion receiving 16 bit dialogue window information of the device from a first operating system supporting a 16 bit device control portion;
- a second interface portion receiving 32 bit dialogue window information of the device from a second operating system supporting a 32 bit device control portion;
- a bit converting portion converting the received 16 bit dialogue window information to converted 32 bit dialogue window information and outputting the converted 32 bit dialogue window information; and
- a dialogue window display portion displaying a 32 bit dialogue window corresponding to the converted 32 bit dialogue window information and not displaying a 16 bit dialogue window.

**As to claim 5:**

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) the bit converting portion comprises: a base dialogue window generating portion generating a 32 bit base dialogue window information having no content of the 32 bit dialogue window and outputting the generated 32 bit base dialogue window information; and

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a data modification portion modifying the received 16 bit dialogue window information to the converted 32 bit dialogue window information and outputting the converted 32 bit dialogue window information to the dialogue window display portion to display the 32 bit dialogue window corresponding to the converted 32 bit dialogue window information, in response to the 32 bit base dialogue window information.

**As to claim 6:**

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) the dialogue window information comprises a plurality of dialogue window page information, and wherein the dialogue window display portion displays as the converted 32 bit dialogue window information, converted 32 bit page information or 32 bit page information, in response to a request by a user for one of the dialogue window page information by requesting the bit converting portion or the second interface portion to provide the converted 32 bit page information or the 32 bit page information, respectively.

**As to claim 7:**

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) the 16 bit dialogue window information comprises a plurality of 16 bit dialogue window page information, and wherein the bit converting portion, in response to a request by the dialogue window display portion for a converted 32 bit dialogue window page information as the converted 32 bit dialogue window information, requests the first interface portion to provide one of the 16 bit dialogue window page information of the 16

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bit dialogue window information, converts the requested 16 bit dialogue window page information to the converted 32 bit page dialogue window information, and outputs the converted 32 bit page information to the dialogue window display portion.

**As to claim 8:**

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) machine readable data storage storing a device driver program controlling a computer to display a device driver dialogue window to interface with a device regardless of the number of bits supported by the computer operating system, according to a process comprising:

- receiving a request from an operating system supporting a 16 bit device driver to display a 32 bit dialogue window for exchange of information between a user and the device and not a 16 bit dialogue window;
- receiving 16 bit dialogue window information of the device from the operating system;
- converting the received 16 bit dialogue window information to 32 bit dialogue window information; and
- displaying the 32 bit dialogue window corresponding to the converted 32 bit dialogue window information and not displaying the 16 bit dialog window.

### **Response to Arguments**

5. Applicant's arguments filed 03/07/08 have been considered but are moot in view of the new ground(s) of rejection.

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." In re Hyatt 21 1 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (1989) "During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."

Applicant should set forth claims in language that clearly, distinctly, unambiguously, and uniquely define the invention.

### **Conclusion**

6. The prior art made of record, see PTO 892, and not relied upon is considered pertinent to applicant's disclosure. Applicant should review these references carefully before responding to this office action.

### **Contact Information**

7. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM-6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MENG-AI AN can be reached at (571) 272-3756.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VAN H NGUYEN/  
Primary Examiner, Art Unit 2194